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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/773,949      | 02/06/2004  | Christopher J. Cookson | 3054-055            | 7978             |

22440 7590 08/16/2006

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EXAMINER

DUNN, MISHAWN N

ART UNIT PAPER NUMBER

2621

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/773,949 | Applicant(s)<br>COOKSON ET AL. |  |
|                              | Examiner<br>Mishawn N. Dunn   | Art Unit<br>2621               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-11,13-23 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-11 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 17-19,23 and 25-37 is/are rejected.
- 7) ☒ Claim(s) 20-22 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/20/06</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 7/13/2006 have been fully considered but they are not persuasive. Applicant argues that Ogino does not teach the claimed invention. It is argued that a check is first performed to determine if a RAM is present, then the CCI bits are evaluated, but the independent claims recite, "if the RAM is present and the CCI bits are present, then..." and "if the RAM is present but the CCI bits are not, then...." It is not specified that the applicant is using a two-step process. Therefore, Ogino discloses the previous limitations of independent claims 1, 11, 17, and 23.
2. The objection of claims 18, 19, and 25-28 has been withdrawn due to newly found prior art.
3. The objection of the drawings has been withdrawn due to submission of amended drawings.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

TTG  
8/7/96

6. Claims 17-19, 23, and 25, 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over ~~Ogino (US Patent No. 6,433,946)~~ in view of Applicant's Admitted Prior Art. ~~Ogino (US Pat. No. 6,433,946).~~ *Art.*

7. Consider claim 17. As admitted by applicant in the specification (pgs. 4-5), Ogino teaches a method for processing an analog video signal that represents a work for which rights information is asserted, the signal including a rights assertion mark (RAM) in the video portion of the signal within the visible picture such that capture of the picture will include the mark, and copy control information (CCI) bits for representing copying rules; comprising the steps of: determining if the RAM and CCI bits are present in the work, if the RAM is present and the CCI bits are present, then applying the copying rules represented by the CCI bits, and if the RAM is present but the CCI bits are not, then applying default copying rules.

Ogino does not specifically teach that the CCI bits are being represented as CGMS-A information.

However, also admitted by applicant in the specification (pg. 2, paragraph 5), it is well known for CCI bits to be represented as CGMS-A information (pg. 2, paragraph 5).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to use, to represent CCI bits as CGMS-A information, in order to minimize signal processing.

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8. Consider claim 18. As admitted by applicant in the specification (pg. 2, paragraph 5), it is well known to have a method for processing an analog video signal that represents a work for which rights information is asserted wherein the CCI bits are provided in the vertical blanking interval of the analog video signal.

9. Consider claim 19. As admitted by applicant in the specification (abstract; pg. 6, paragraph 4), Broughton et al. teaches a method for processing an analog video signal that represents a work for which rights information is asserted wherein the RAM is represented by VEIL modulation of the video signal.

10. Consider claim 37. As admitted by applicant in the specification (pg. 6, paragraph 1), Ogino teaches the method wherein in the absence of said CCI bits, said device is operated in a mode in which said analog video signal cannot be recorded.

11. Claims 23, 25, and 29-36 are rejected for the same reasons as the corresponding claims above.

12. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over ~~Harai~~ Ogino in view of Applicant's Admitted Prior Art and further Applicant's Admitted Prior Art, Ogino (US Pat. No. 6,433,940), in view of Harai (US Pat. No. 6,850,619).

13. Consider claim 26. Applicant's admitted prior art discloses all the claimed limitations as stated above, except a method for asserting and identifying rights information in a work represented by an analog video signal further including the step of inserting in the signal secondary copy control information (SCCI) that conforms with the CCI bits.

However, Harai teaches inserting in the signal secondary copy control information that conforms with the CCI bits (abstract; fig. 1).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to use, to insert secondary copy control information that conforms with the CCI bits, in order to provide a more reliable copyright protection system.

14. Consider claim 27. Applicant's admitted prior art discloses all the claimed limitations as stated above, except a method for asserting and identifying rights information in a work represented by an analog video signal wherein the SCCI bits are in the form of a watermark in the audio portion of the work.

However, Harai teaches that the SCCI bits are in the form of a watermark in the audio portion of the work (abstract; col. 8, lines 50-52).

15. Consider claim 28. Applicant's admitted prior art discloses all the claimed limitations as stated above, except a method for asserting and identifying rights information in a work represented by an analog video signal wherein the SCCI bits are in the form of a digital signature in the vertical blanking interval of the analog video signal, where the digital signature is a function of the CCI bits and selected pixels of the visible picture portion of the work.

However, Harai teaches that the SCCI bits are in the form of a digital signature in the vertical blanking interval of the analog video signal, where the digital signature is a function of the CCI bits and selected pixels of the visible picture portion of the work

(inherent; since a watermark is a form of a digital signature, the SCCI bits (audio watermark) are in the form of a digital signature).

***Allowable Subject Matter***

16. Claims 1, 4-11, and 13-16 are allowable over prior art.
17. Claims 20-22 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

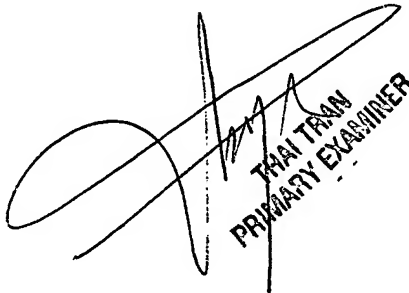
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is 571-272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mishawn Dunn  
March 28, 2006



THAI TRAN  
PRIMARY EXAMINER